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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/067,809	02/08/2002	Michael J. Rochon	11009-0019	9593

7590 12/31/2002  
Clark & Brody  
Suite 600  
1750 K Street, NW  
Washington, DC 20006

EXAMINER

PAK, JOHN D

ART UNIT	PAPER NUMBER
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1616

DATE MAILED: 12/31/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/067,809

Applicant(s)

ROCHON, MICHAEL J.

Examiner

JOHN D PAK

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 October 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-45 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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Claims 1-45 are pending in this application.

Applicant's election of 1-hydroxyethylidene-1,1-diphosphonic acid as the single disclosed species of the phosphorus-based acid and C8-16 alkylaryl sulfonic acid/salt (as recited in claim 1) as the single disclosed species of anionic surfactant in Paper No. 5 (10/15/02) is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). Claims 1-45 will presently be examined to the extent that they read on the elected subject matter.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-45 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-14 of U.S. Patent No. 6,346,279. Although the conflicting claims are not identical (broader pH and weight ranges, combination of part (iv) ingredient), they are not patentably distinct from each other because the patented claims recite the same ingredients at slightly narrower weight ranges, which ranges are clearly encompassed by the present claims. All additives are shown in the patented claims and their combination would have been obvious as each has been individually shown to be suitable and advantageous in combination with hydrogen peroxide and anionic surfactants. In re Sussman, 58 USPQ 262, 264-65 (CCPA 1943); see In re Kerkhoven, 205 USPQ 1069, 1072 (CCPA 1980). Therefore, one having ordinary skill in the art would have concluded that the claimed invention herein is an obvious variation of the invention defined in the claims of the cited patent.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

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At the outset, it is noted for the record that the present ground of rejection is applicable only to the extent that the claims read on subject matter that is not encompassed by the claimed subject matter of U.S. Patent No. 6,346,279. During the prosecution of the application from which said patent issued, applicant was able to establish sufficient nonobvious evidence relevant to the scope of the allowed/now-patented claims. Present claims under examination read on subject matter that is outside of the scope of the patented claims, and it is that subject matter that is being rejected herein.

Claims 1-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scoville (WO 98/11777) in view of Kennedy, Jr. (US 4,637,899) and Block.

Scoville discloses an aqueous disinfecting and sterilizing anticorrosive composition comprising 0.5-50% hydrogen peroxide, 0.001-10% organic or inorganic acid, corrosion inhibitor, and various adjuvants (see from p. 3, line 13 to p. 9, line 13). The acid component can be, for example C1-4 carboxylic acid, inclusive of dicarboxylic acid (p. 5, first full paragraph). pH of the composition is below about 5, preferably below about 3 (p. 7, lines 7-11). Chelating agent is added to "enhance biological activity," and includes the elected 1-hydroxyethylidene-1,1-diphosphonic acid (p. 8, lines 20-22) at low amounts such as 0.7 wt% and 3 wt% (see p. 12, Compositions I and II). Stabilizing agents for hydrogen peroxide is included (p. 7, lines 14-22). Up to about 30 wt% of a surfactant is included (see from p. 7, line 23 to p. 8, line 17). Alkylaryl sulfonates such as sodium dodecylbenzenesulfonate is specifically disclosed (p. 8, line 7-8), as

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well as oxyethylated straight chain alcohol and the polyoxyethylene surfactant T-Det N 9.5 (see the paragraph bridging pages 7 and 8).

Kennedy, Jr. (hereinafter, Kennedy) discloses a corrosion inhibitor composition that includes solubilizing alcohols such as isopropanol and a surfactant such as alkyl sulfonated diphenyl oxides (see column 3, lines 18-23 and 38-45).

Block is cited to establish that hydrogen peroxide, acids and surface active agents are known to possess individual disinfecting properties (pp. 167-180, 256-271).

While the prior art does not explicitly the specific combination and proportion of all ingredients, as claimed, it is nonetheless suggestive of the same. Hydrogen peroxide, acids and surface active agents are known to be used together and possess individual disinfecting activity. A chelating agent such as the elected 1-hydroxyethylidene-1,1-diphosphonic acid is expected to enhance biological activity of the disinfecting ingredients. Adjuvants such as the elected C8-16 alkylaryl sulfonic acid (e.g. dodecyl benzene sulfonic acid/salt), dicarboxylic acid, polyoxyethylene surfactant have been taught to be usable together in a hydrogen peroxide disinfecting system, and corrosion inhibitors that include alcohol and alkyl sulfonated diphenyl oxides would have been suggested for maintenance of metal surfaces in contact with the cleaning, disinfecting hydrogen peroxide solution. In re Sussman, 58 USPQ 262, 264-65 (CCPA 1943); see In re Kerkhoven, 205 USPQ 1069, 1072 (CCPA 1980).

Therefore, the claimed invention, as a whole, would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made, because every element of the

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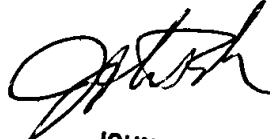
invention and the claimed invention as a whole have been fairly suggested by the teachings of the cited references.

A facsimile center has been established in Technology Center 1600. The hours of operation are Monday through Friday, 8:45 AM to 4:45 PM. The telecopier numbers for accessing the facsimile machines are (703) 308-4556 or (703) 305-3592.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Examiner Pak whose telephone number is (703) 308-4538. The Examiner can normally be reached on Monday through Friday from 7:30 AM to 4 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Mr. José Dees, can be reached on (703) 308-4628.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1235.



JOHN PAK  
PRIMARY EXAMINER  
GROUP 1600